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27 MAY 2008

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In re Application of	:	DECISION ON
SAINTY et al	:	
PCT No.: PCT/AU2004/001082	:	
Application No.: 10/577,421	:	PETITION UNDER
Int. Filing Date: 13 August 2004	:	
Priority Date: 13 October 2003	:	
Attorney's Docket No.: ST005.US	:	37 CFR 1.47(a)
For: ION SOURCE CONTROL SYSTEM	:	

This decision is in response to petitioner's "Petition Under 37 CFR 1.47(a)" submitted on 09 April 2008, requesting the acceptance of the application without the signature of the inventor William Waller. Petitioner has submitted the requisite \$200 petition fee by check.

BACKGROUND

On 13 August 2004, applicants filed international application PCT/AU2004/001082, which claimed priority of an earlier application filed 31 October 2003. A copy of the international application was transmitted to the United States from the International Bureau on 19 May 2005.

On 27 April 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). An executed declaration was submitted but it did not have the signature of the second named inventor, William Waller.

On 10 January 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495" which informed applicants that the 371(c)(1), (c)(2) and (c)(4) and that the date of completion of all 35 U.S.C. 371 is 27 April 2006.

On 09 April 2008, petitioner filed the current petition under 37 CFR 1.47 to proceed without the signature of inventor William Waller.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written

refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied items (1), (3), and (4) of 37 CFR 1.47(a). However, item (2) has not been satisfied.

Regarding item (1), the correct petition fee of \$200.00 has been paid.

Regarding item (2), the averments of Darren Gardner are not sufficient to support a finding that the nonsigning inventor, Waller refuses to sign because it is unclear if a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, and that the inventor refused to return the correspondence.

Also, where the Office is being asked to accept the silence of the nonsigning inventor's as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant. Absent further firsthand evidence that the application and request for signature were received by the nonsigning inventor, item (2) cannot be considered satisfied.

In addition, it is unclear if Mr. Waller still resides in that address. If not, then petitioner is under an obligation to try to find or reach Mr. Waller. Where there is an inability to find or reach a joint inventor "after diligent effort," petitioner may file a statement of facts that fully describes the exact facts which are relied on to establish that a diligent effort was made under **37 CFR 1.47**.

Also Gardner states that searches of telephone directories were made, the list has not been provided. Moreover, Darren Gardner has not shown that a searched for the above non-signing inventor's new address was done by a broad search in the internet in addition to a phone directory listing, which would show diligent effort by him to find the nonsigning inventor.

Finally, it is not clear from the petition that it was Darren Gardner who performed the items listed in the petition, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Darren Gardner was not the person who performed the actions listed in the petition, then petitioner will need to submit statements, with specific facts on the actions referred by the petition from persons, who have first-hand knowledge of such facts.

Regarding item (3), petitioner has provided a statement of the last known address of the missing inventor.

Regarding item (4), petitioner has provided an executed declaration signed by Wayne Sainty on his behalf and on the behalf of the nonsigning joint inventor William Waller.

Consequently, at this time it can not be concluded that the nonsigning Mr. Waller could not be reached after diligent effort or refuses to sign as stipulated under 37 CFR 1.47(a).

As a result, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

The Notification of Acceptance (Form PCT/DO/EO/903) mailed on 10 January 2007 is **VACATED** with the mailing of this decision because it was erroneously mailed.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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